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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,443	06/25/2003	James N. Buttrick JR.	BING-1-1002	2939
25315	7590	09/06/2005	EXAMINER	
BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			TALBOT, MICHAEL	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/606,443	BUTTRICK ET AL.	
	Examiner	Art Unit	
	Michael W. Talbot	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-42 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-11, 13-18, 21-24, 26-33 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 12, 19, 20, 25 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/25/03, 04/01/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “first and second elongated flexible rails” recited in claims 13 and 26 in combination with the “biasing device” recited in claims 1 and 14, respectively, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

Refer to page 5, line 23, the character reference “base member 126” should be changed to read --base member 122--.

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Referring to the Specification from page 14 on, character reference "manufacturing assembly 300" has been referenced without proper indexing to the appropriate figures. The number "300" should be removed entirely from the specification or Figure 12 must be revised to properly index the character reference "manufacturing assembly 300" in lieu of "manufacturing assembly 300".

Refer to page 14, line 28, the character reference "motor 3332" should be changed to read --motor 332--.

Appropriate correction is required.

### ***Claim Objections***

3. Claim 1 and 15 are objected to because of the following informalities:

Refer to claim 1, line 5, remove the comma " , " from the phrase "workpiece,; and" to read --workpiece; and--.

Refer to claim 15, line 1, change the word "oa" to read --one--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The further limitations of the base recited in claim 13, specifically a first and second elongated flexible rails with a plurality of vacuum attachment devices connected to each rail, have not been shown in combination with the apparatus as recited in claim 1.

The further limitations of the base recited in claim 26, specifically a first and second elongated flexible rails with a plurality of vacuum attachment devices connected to each rail, have not been shown in combination with the apparatus as recited in claim 14.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,8,9,11,17,21,22,24 and 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 17 recite the limitation "in first and second directions" in lines 1 and 2.

There is insufficient antecedent basis for this limitation in the claims.

Claims 8 and 21 recite the limitation "the biasing axis" in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claims 9 and 22 recite the limitation "the biasing axis" in line 2. There is insufficient antecedent basis for this limitation in the claims.

Claims 11 and 24 recite the limitation "the translation direction" in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claims 17 and 28 recite the limitation "the biasing axis" in line 1. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,8-11,14-17,21-24,27-32 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Balcombe '931. Balcombe '931 shows in Figures 1-3 an apparatus comprising a base (11,13,15,17) adapted to be attached to the workpiece, a tool support (28,35,37) coupled to the base and moveable along a translation axis (vertical direction), and a biasing device (22) coupled to the base and the tool support and being adapted to at least partially counterbalance a force exerted on the tool support along the translation axis (col. 1, lines 60-63). Balcombe '931 shows the translation axis has at least a component perpendicular to a local normal to the surface (which is in the horizontal direction) of the workpiece being in the vertical direction. Balcombe '931 shows the tool support is slideably coupled to the base along guide rails (17) and moveable in a first (vertically upwards) direction and a second (vertically downwards) direction. Balcombe '931 shows the biasing direction and the biasing axis are along the same direction as the translation axis (vertical direction). Balcombe '931 shows a carriage assembly (20,24,28,31,37) coupled to the tool support and moveably coupled to the guide rails. Balcombe '931 shows a translation direction (tool 31 along guides 28) at least partially transverse to the elongated rail member (col. 2, line 61 through col. 3, line 7). Balcombe '931 shows manufacturing tool (31) coupled to the tool support and adapted to engage the workpiece surface to perform a manufacturing operation.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claims 1,4,8,9,14,17,21,22,28,30,31,32,36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Oster '159. Oster '159 shows in Figures 1-3 an apparatus comprising a

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base (4) adapted to be attached (via suction cup 40) to the workpiece (2), a tool support (6,8,30) coupled to the base and moveable along a translation axis (vertical direction), and a biasing device (24) coupled to the base and the tool support and being adapted to at least partially counterbalance a force exerted on the tool support along the translation axis (col. 3, lines 30-32). Oster '159 shows the tool support is moveable in a first (vertically upwards) direction and a second (vertically downwards) direction. Oster '159 shows the biasing direction and the biasing axis are along the same direction as the translation axis (vertical direction). Oster '159 shows manufacturing tool (26,28) coupled to the tool support and adapted to engage the workpiece surface to perform a manufacturing operation.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5,8-10,14-18,21-23,28-33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Barclay '792. Barclay '792 shows in Figures 1-4 an apparatus comprising a base (40,50) adapted to be attached (via 50) to the workpiece, a tool support (60) coupled to the base and moveable along a translation axis (inclined direction), and a biasing device (80,90,100,110) coupled to the base and the tool support and being adapted to at least partially counterbalance a force exerted on the tool support along the translation axis (col. 3, lines 31-33 and col. 5, lines 26-30). Barclay '792 shows the translation axis has at least a component perpendicular to a local normal to the surface (parallel to tool axis) of the workpiece being in the inclined direction. Barclay '792 shows the tool support is slideably coupled to the base along a guide rail (40) and

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moveable in a first (inclined upwards) direction and a second (inclined downwards) direction. Barclay '792 shows the biasing device including a pneumatic actuator (100,110). Barclay '792 shows the biasing direction and the biasing axis are along the same direction as the translation axis (inclined direction). Barclay '792 manufacturing tool (70) coupled to the tool support and adapted to engage the workpiece surface to perform a manufacturing operation.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

***Allowable Subject Matter***

8. Claims 6,7,12,19,20,25 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 38-42 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 38 is the independent claim.

The Prior Art of Record fails to anticipate or obviate the specific steps in the specific sequential order as presented by the Applicant, specifically the final three steps of (1) securely engaging the manufacturing tool with the surface of the workpiece, and (2) with the manufacturing tool securely engaged with the surface of the workpiece, detaching the support member from the surface of the workpiece, and (3) with the manufacturing tool securely engaged with the surface of the workpiece, moving the support member relative to the manufacturing tool.

10. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's



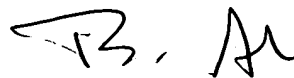
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office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Boyer D. Ashley, may be reached at 571-272-4502

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot  
Examiner  
Art Unit 3722  
16 August 2005



BOYER D. ASHLEY  
PRIMARY EXAMINER